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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,954	08/31/2001	Chris Quackenbush	472712000100	7652
7590	09/08/2006		EXAMINER	
Kevin R. Spivak Morrison & Foerster LLP Suite 5500 2000 Pennsylvania Avenue, N.W. Washington, DC 20006-1888			AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 09/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,954	QUACKENBUSH ET AL.	
	Examiner	Art Unit	
	Olabode Akintola	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 August 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-47 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-47 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly in claim 1, it is not clear how the method steps (retrieving and merging data) achieve valuating and analyzing finances as recited in the preamble.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 6, 8, 13, 14, 25-28, 30, 32, 35, 39-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Erwin et al (USPN 6249770) (Erwin).

Re Claims 1-3, 14, 27-28, 30 and 41-47: Erwin teaches a method for valuating and analyzing finances, comprising: retrieving financial data and assumptions from external databases; merging the retrieved financial data; storing the merged financial data in an internal financial database; and retrieving the financial data and assumptions from the internal financial database and processing the retrieved financial data based on the retrieved assumptions (col. 15, lines 1-18).

Re Claims 6, 8 and 32: Erwin teaches displaying the financial data and assumptions to be processed by the analytic tool to a user such that the user replaces a portion of the financial data and assumptions with data which the user selects (col. 4, lines 27: Fig 23).

Re Claims 13, 26, 35 and 40: Erwin teaches providing a result of the financial valuation in a form of a table, a balance sheet or an income statement (col. 12, lines 43-49).

Re Claim 25 and 39: Erwin teaches the step wherein the financial data and assumptions to be processed by the analytic tool are stock prices, profitability measurements, historical corporate trends, deal considerations, deal pricing, deal accretions, accounting methods, amortization periods of good will, cost savings, opportunity costs of cash, effective tax rates, deal expenses,

earnings estimates, net income projections, or earnings growth rates (col. 1, lines 24-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 15, 29, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin in view of Northington et al (USPN 6128602) (Northington).

Re claims 4, 15, 29, 36 and 37: Erwin does not explicitly teach the step of updating the financial data and assumptions stored in the internal financial database at least once a day. Northington teaches the step of updating the financial data and assumptions stored in the internal financial database at least once a day (col. 13, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Erwin to include this step as taught by

Northington. One would have been motivated to do so in order to avoid processing outdated/stale data.

Claims 5, 9, 12, 17-24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin in view of Wherry et al (USPAN 20020038273) (Wherry).

Re claims 5, 9, 12, 17-24 and 31: Erwin does not explicitly teach the step of selecting the analytic tool from a plurality of analytic tools, wherein each of the analytic tools provides analysis. Wherry teaches the step of selecting the analytic tool from a plurality of analytic tools, wherein each of the analytic tools provides analysis (section [0055]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Erwin to include this step as taught by Wherry. One would have been motivated to do so in order to provide the user with increased flexibility.

Note claims 17-24: These claims recite the use of the selected analytic tool. These recitations are treated as intended use of the selected analytic tool. The examiner notes that the intended use (or field of use) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

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Claims 7, 16, 33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin in view of Menninger et al (USPN 6954736) (Menninger).

Re claims 7, 16, 33 and 38: Erwin does not explicitly teach the step of issuing a warning to the user when the financial data and assumptions do not meet the predetermined standard.

Menninger teaches the step of issuing a warning to the user when the financial data and assumptions do not meet the predetermined standard (col. 132, lines 33-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Erwin to include this step as taught by Menninger. One would have been motivated to do because it is a well-known business practice to issue alerts when data is compromised.

Claims 10, 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin in view of Tomida et al (USPN 6260026) (Tomida).

Re claims 10, 11 and 34: Erwin does not explicitly teach the step finding a missing portion of the financial data and assumptions to be processed by the analytic tool, and retrieving data corresponding to the missing portion from the internal financial database or calculating necessary data using data retrieved from the internal financial database. Tomida teaches the step finding a missing portion of the financial data and assumptions to be processed by the analytic tool, and retrieving data corresponding to the missing portion from the internal financial database or calculating necessary data using data retrieved from the internal financial database (col. 9, line 46-col. 10, line 17). It would have been obvious to one of ordinary skill in the art at the time of

the invention to modify Erwin to include this step as taught by Tomida. One would have been motivated to do in order to restore the missing portion before processing by the analytic tool.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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